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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,103	05/24/2005	Nikolaus Farber	P16687-US1	6851
27045	7590	03/17/2009		
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			EXAMINER FAHNERT, FRIEDRICH	
			ART UNIT 4153	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/512,103	<b>Applicant(s)</b> FARBER ET AL.	
	<b>Examiner</b> FRIEDRICH FAHNERT	<b>Art Unit</b> 4153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04/24/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/21/2004, 06/07/2006</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

### ***Claim Rejections -35 USC §101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-13, 18-19, 25-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claim 1, the steps of "receiving" and "transmitting" of information for initiating the bypassing of transcoding are merely data exchange over a wireless network. Thus, claim 1 is not a statutory process. Claims 2-13 are also rejected for the same basis.

With respect to Claim 18, a computer program is merely a set of instructions capable of being executed by a computer; the computer program itself is not a process and therefore is considered as non-statutory functional descriptive material. Claim 19 refers to a computer readable medium that does

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not constitute a statutory process, machine, manufacture, or composition matter because the medium could potentially be by a wireless network and is therefore rejected.

With respect to Claims 25-28, a "message" can be considered as a data structure and does not involve steps that "transform" any data per se; therefore, the mentioned Claims are merely functional descriptive material and by itself are not statutory. See MPEP 2106.01 which stipulates: "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

Claim 5 refers to a "list of encoding formats" is not statutory, this claim does not involve steps that "transform" any data per se. Therefore, the method as claimed is merely functional descriptive material and by itself is not statutory.

### ***Claim Rejections -35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Tseng et al, US 6,172,974.

Claim 1 is anticipated by Tseng et al. where a method is presented to perform the bypassing of a pair of transcoders one on the local side the other at the distant side of the communication network (column 5, line 62-67, column 6, line 1-5).

Consider claim 2, Tseng et al. teaches a method that provides cross transcoding (column 5, line 62-67).

Consider claim 3, Tseng et al. teaches a method to determine if the distant side is able to support other encoding formats compatible with the local side of the network (column 6, lines 6-28, Table 1).

Consider claim 4, Tseng et al. teaches a method based on signaling scheme to change the encoding format on the basis of alternative encoding (column 8, lines 43-45).

Consider claim 5, Tseng et al. shows the encoding capabilities and list of supported formats (Table 1).

Consider claim 7, Tseng et al. teaches steps for changing the encoding format (Figure 3)

Consider claim 8, Tseng et al. teaches a method to achieve tandem free operation, providing transcoding when required, and providing conventional tandemed vocoding when vocoder of the terminal elements are incompatible (column 5, line 63-67).

Claim 18 is anticipated by Tseng et al. where the invention comprises a “signaling algorithm to achieve TFO across a communication network” (column 5, line 44-50).

Consider claim 20, Tseng et al. teaches an apparatus for processing signals in context with the initiation of a bypass of a pair of transcoders located on either side of the communication network ( column 2, line 51-65).

Consider claim 25, Tseng et al. teaches a message flow sequence in order to initiate and perform the bypass of a pair of transcoders located at either side of the communication network (Figure 2, column 6, line 6-12).

Claim 9, 11, 12, 13, 14, 27, 28, rejected in view of Claim 1, does not add more than what Claim 1 has recited.

Claim 10, rejected in view of Tseng et al. where Tseng teaches the encoding capabilities of the distance side using a frequency table (column 7, lines 37-58, Table 1).

Claim 15, 16, 17 rejected in view of Tseng et al. Tseng teaches a method to achieve TFO by providing cross transcoding when the transcoders of the particular terminal or network are not identical, and providing transcoding when the transcoders are identical (column 5, line 63-67).

Claim 21, 22, 23, rejected in view of Tseng et al. includes a transcoding device, components for evaluating local and distance encoding information, and a transcoding control (Fig. 4).

Claim 24, rejected in view of Tseng et al.

Claim 26, rejected in view of Tseng et al. refers to encoding capabilities in Table 1.

***Claim Rejections -35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng et al. in view of Shaffer et al. (Patent Number US 6,324,409).

The rejection of claim 1 is incorporated herein. Tseng does not address the limitations of claim 6, but Shaffer et al. teaches a method to optimize voice quality by determining a minimum number of new of transcodings and also determines an optimized series of transcoders to be used for the call (column 2, line 63-67). Therefore, the combined teachings of Tseng and Shaffer as a whole would have rendered obvious determining the optimal encoding configuration based on compatible encoding formats.

**Contact Information**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRIEDRICH FAHNERT whose telephone number is (571)270-7797. The examiner can normally be reached on Monday through Thursday 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Le Vu can be reached on 571-272-7322. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/FRIEDRICH FAHNERT/  
Examiner, Art Unit 4153

/Vu Le/  
Supervisory Patent Examiner, Art Unit 4153